

AMENDMENTS TO THE DRAWINGS:

The attached sheet of drawings includes changes to Fig. 4. This sheet, which includes Fig. 4, replaces the original sheet including Fig. 4. In Figure 4, a step S50 was added.

Attachment: Replacement Sheet (1 sheet)

REMARKS

Claims 1-20 are pending in this application. Claims 1 and 20 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

I. Drawings

The Examiner states that drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “selecting of an advance-transmitting function” of claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The original specification on page 8, lines 10-13, supports the feature as “First, an advance-transmitting function is selected. Then, the telephone number of the receiving part facsimile 200 is input using the number and letter generating unit 172 of the OPE 170 as shown in FIGs. 2 and 5. In order to transmit fax data from the transmitting part facsimile 100 to the receiving part facsimile 200, a document is scanned and stored in the memory 150 (S100).”

Therefore, to accommodate the Examiner’s request, a step S50 was added to the particular text.

II. Claim Objections

The following quotations of 37 CFR §1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

The Examiner states that Claim 1 recites the limitation “a facsimile receiving part” in line 4, and there is insufficient antecedent basis for this limitation in the claim and it should be “said facsimile receiving part”. Claim 1 was amended according to the Examiner’s suggestion.

III. Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A. The Examiner stated the following:

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 18 fails to correspond in scope with that which applicant regard as the invention can be found in page 8 of the original Specification filed 5/26/00. In that paper, applicant has stated “[f]irst, an advance-transmitting function is selected. Then, the telephone number of the receiving part

facsimile 200 is input using the number and letter generating unit 172 of the OPE 170 as shown in figs. 2 and 5”, and this statement indicates that the invention is different from what is defined in the claim because the claim recites that the selecting of the advance-transmitting function is performed when said call is connected. Moreover, referring to fig. 4, the Specification seems to indicate that the selection is done before S100. However, the claim defines the selection to be done after S300. For the examining purpose, the examiner interprets the selection to be done before S100 as it is defined in the Specification.

Claim 18 states, that the selection of the advance-transmitting function “accommodate” said requiring said data output order, which does not mean that it is done after S300 but that it accommodates such a step. Moreover, the specification on the last paragraph states “This invention has been described above with reference to the aforementioned embodiments. It is evident, however, that many alternatives, modifications and variations will be apparent to those having skill in the art in light of the foregoing description. Accordingly, the present invention embraces all such alternatives, modifications and variations as fall within the spirit and scope of the appended claims and their equivalents.”

Therefore, the order given in the drawings are an example but not limited to such as one of ordinary skill would have made certain modifications and variations. The limitations are given in the claims and not in the description of the aforementioned embodiments.

Additionally, such a rejection is a new rejection that is not based upon any amendments by the Applicant. Claim 18 was not amended to afford such a 112 rejection according to MPEP§706.07.

B. Claim 20 is rejected under 35 U. S. C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states that it is uncertain as to whether said data output order is displayed again on another operational panel when said data output order is received from facsimile receiving part is already displayed according to the last part of claim 8. Further, it is unclear as to whether “an operational panel” recited in claim 20 is the same operational panel recited in claim 8. Additionally, “further comprised” should be -- further comprising --.

First of all, the proper terminology would be “further comprised” as it is related to a previous step of “displaying said data output order received from said facsimile receiving part on a display on an operational panel”. Concerning the operational panel, it was corrected to said operational panel.

IV. Claim Rejections - 35 USC § 102

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as

complete detail as is contained in the patent claim. *Id.*, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

A. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al. U.S. Patent No. 6,449,063 (hereinafter Yoshida). The Applicant respectfully traverses.

1. With respect to claim 1, the Examiner stated that Yoshida teaches a method for controlling transmission of fax data according to a data output order of a facsimile receiving part (figs. 5, 6 & 9), the method comprising the steps of:

scanning and storing a document into data to be transmitted from a facsimile transmitting part to said facsimile receiving part (col. 5, lines 15-19);

dialing a predetermined telephone number of said facsimile receiving part when said document is completely scanned (S84 in fig. 5);

requiring and receiving said data output order by said facsimile transmitting part from said facsimile receiving part after the telephone number of said facsimile receiving part is dialed (S88); and

transmitting by said facsimile transmitting part, said stored document data according to said received data output order (either both-side transmission or one-side transmission & col. 3, lines 38-48).

However, looking at step S88 of Yoshida does not disclose requiring and receiving said data

output order by said facsimile transmitting part from said facsimile receiving part after the telephone number of said facsimile receiving part is dialed, but instead as mentioned in co. 5, lines 34-37 states that whether the partner station has both-side transmission function or not is discriminated in step S88.

The Examiner stated that transmitting by said facsimile transmitting part, said stored document data according to said received data output order (either both-side transmission or one-side transmission & col. 3, lines 38-48). However, in col. 3, lines 38-48 only states that there is a transmission according to the order of the front side to the reverse side, but it does not state that such an order is the “received output order” but rather merely the front side to the reverse side order.

2. With respect to claim 6, Yoshida teaches the method of claim 1, with said requiring of said document order being made during Phase B of a facsimile transmission, Phase B being a sequence of checking states of said facsimile transmitting part and a transmission line and controlling said facsimile transmitting part among a plurality of predetermined protocols used in transmission and reception of facsimile data (col. 7, line 66 - col. 8, line 9 & figs. 12-15).

However, looking at figure 10 of Yoshida, it not clear that requiring of said document order being made during Phase B of a facsimile transmission as figure 10 shows the DIS, DTC and DCS signals regarding the transmission.

3. With respect to claim 7, the Examiner stated that Yoshida teaches the method of claim 1,

with said dialing a predetermined telephone number of said facsimile receiving part being automatic (S84 in fig. 5).

However, step S84 states that the destination is called by using the calling circuit, but that does not mean it is actually automatic. It can use a circuit to call, but it does not necessarily mean it is automatic then by using a circuit. Further the CCPA has added that “inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Here, it is clear by using a circuit alone does not necessarily mean automatic.

V. Claim Rejections - 35 USC § 103

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

1. With respect to claim 2, the Examiner stated that Yoshida teaches the method of claim 1 but it does not teach expressly the step of displaying said data output order received from said facsimile receiving part, on said facsimile transmitting part.

The Examiner goes on to state that Ishizuka, the same field of endeavor of the facsimile art, teaches the method of inquiring and receiving the destination device output order function wherein the received information is displayed on the operational panel of the transmitting part (col. 7, lines 36-52).

However, Ishizuka only displays whether a destination unit is capable of dual sided reading or recording function only. The claim states specifically, “the data output order received from the facsimile receiving part.” The actual data order received is never displayed. Only the capability is displayed and even then its only if whether the part is capable of dual side only.

2. With respect to claims 4 and 11, the Examiner stated that Yoshida teaches the method of claim 1 wherein said facsimile receiving part reporting said data output order to said facsimile transmitting part by sending a predetermined bit of data (figs. 12-15).

However, figures 12-15 do not show that the data output order that is actually received in the receiving part is sent a predetermined bit of data, but only a capability of the receiving part is sent.

The Examiner goes on to state, Yoshida, however, does not teach expressly that said transmitting part and said receiving part support a non-standard mode, but that Ishizuka, the same field of endeavor of the facsimile art, teaches the method of inquiring and receiving the destination device output order function wherein said facsimile transmitting part and said facsimile receiving part support a non-standard mode (col. 7, lines 55-67).

However, this merely shows that Ishizuka has a non-standard function. Here, the Examiner is now picking a choosing based on the disclosure of the present invention. The Examiner states that suggestion/motivation for doing so would have been to provide a non-standard function in the facsimile communication.

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be “clear and particular” without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.* Respectfully, the motivation given by the examiner of “providing a non-standard function” as that is the limitation itself, is a broad generalized statement.

3. With respect to claim 8, the Examiner stated that Yoshida teaches a method.(figs. 5, 6 & 9), comprising the steps of:

scanning a document into data to be transmitted from a facsimile transmitting part to a facsimile receiving part (col. 5, lines 15-19);

storing said data of said document in a memory of said facsimile transmitting part (S72 in fig. 5);

making a call by dialing a predetermined telephone number of said facsimile receiving part when said document is completely scanned and stored in said memory (S84 in fig. 5);

checking whether said call between said facsimile transmitting part and said facsimile receiving part is connected (fig. 12);

requiring a data output order by said facsimile transmitting part from said facsimile receiving part when said call is connected (S88);

receiving said data output order by said facsimile receiving part from said facsimile transmitting part after said requiring of said data output order (S88); and

transmitting said data of said document stored in said memory according to said received data output order (either both-side transmission or one-side transmission & col. 3, lines 38-48).

However, step S88 is not teaching requiring a data output order by said facsimile transmitting part from said facsimile receiving part when said call is connected but only whether the partner station has both-side transmission function which is only the capability.

The Examiner goes on to state that Yoshida, however, does not teach expressly the step of displaying said data output order received from said facsimile receiving part, on said facsimile transmitting part, but that Ishizuka, the same field of endeavor of the facsimile art, teaches the method of inquiring and receiving the destination device output order function wherein the received information is displayed on the operational panel of the transmitting part (col. 7, lines 36-52).

However, Ishizuka only teaches of displaying a capability of the facsimile machine rather than displaying the data output order received by the facsimile receiving part.

4. With respect to claim 9, the Examiner stated that Yoshida teaches the method with said dialing the predetermined telephone number being automatically dialed when said document is completely scanned (S84 in fig. 5). However, again as stated above, using a circuit to call does not mean it is necessarily automatic.

5. With respect to claim 18, the Examiner stated that Ishizuka, teach the method further comprising of selecting an advance-transmitting function to accommodate said requiring said data output order by said facsimile transmitting part from said facsimile receiving part when said call is connected (col. 7, lines 33-52 & col. 8, lines 32-41).

However, looking at cols. 7-8, no such advanced transmitting function is actually selected to accommodate the requiring of the data output order.

6. With respect to claim 19, the Examiner stated that Ishizuka teach the method, wherein after the data output order of the facsimile data is displayed on a display of said operational panel, the facsimile data stored in a memory is then transmitted to said facsimile receiving part according to the displayed data output order (col. 8, lines 32-41).

However, looking at col. 8 does not indicate a display in such an order, it only states that the communication is identified, but not displayed.

7. With respect to claim 20, the Examiner stated that Ishizuka teaches the method, further comprised of displaying said data output order when said data output order is received from said facsimile receiving part on a display on an operational panel (col. 7, lines 36-52).

However, col. 7 does not teach a display and it does not teach or suggest at all that there is a display of actual received data output order. This is clearly not taught or suggested and to assume otherwise would be improper.

B. Claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Ishizuka and in further in view of Bloomfield U.S. Patent No. 6,693,729. The Applicant respectfully traverses.

8. With respect to claim 13, the Examiner states that Yoshida discloses a facsimile transmitting part apparatus, comprising:

a scanner of said facsimile transmitting part scanning data of a document and converting the data into digital image data (col. 5, lines 15-19);

a control unit utilizing the digital image data from said scanner, said control unit controlling said facsimile transmitting part according to a system program, said control unit requiring and receiving a document output order from a facsimile receiving part (S88), said document output order being an order of document pages determined by and being printed on said facsimile receiving part (either both-side transmission or one-side transmission & col. 3, lines 38-48);

a memory storing said system program guiding said control unit, the digital image data from the document being stored in said memory before being transmitted to said facsimile part by a transmission signal from said controller (col. 7, lines 1-10); and

a modem through a control of said control unit modulating said digital image data into analog data formatted for transmission over a PSTN (col. 2, lines 42-49).

However, as mentioned above step S88 does not teach or suggest control unit requiring and receiving a document output order from a facsimile receiving part.

The Examiner goes on to state that Yoshida, however, does not disclose expressly an operational panel having a plurality of keys generating key data of said facsimile transmitting part to said control unit, said operational panel having a display unit showing the document output order of said facsimile receiving part, but that Ishizuka, the same field of endeavor of the facsimile art,

discloses a facsimile apparatus having an operational panel having a plurality of keys generating key data of said facsimile transmitting part to said control unit, said operational panel having a display unit showing the document output order of said facsimile receiving part (col. 7, lines 33-52).

However, Ishizuka only exhibits a inquiry key 220 to inquire of the dual side status of a destination device which is not the same as the actual document output order.

The Examiner also states that the combination of Yoshida and Ishizuka, however, does not disclose expressly that the network control unit forms a communication loop of the public telephone network having a ring and a tip, but that Bloomfield discloses a facsimile communication system using a communication loop of the public telephone network having a ring and a tip capabilities (col. 4, lines 26-36) and that it would have been obvious to one of ordinary skill in the art to implement the PTSN having a ring and a tip signal into the facsimile system of Yoshida and Ishizuka to provide a facsimile network having a ring and a tip capabilities.

However, again, respectfully, this is not a clear and particular suggestion or motivation but rather a generalized conclusory statement contrived based on the disclosure of the present invention.

C. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida, Ishizuka and Bloomfield as applied to claim 13 above and in further view of Suzuki. The

Applicant respectfully traverses.

The Examiner failed to give an actual reason for the rejection using the references but only stated that with respect to claim 10, arguments analogous to those presented for claim 3, are applicable. We assume that the Examiner meant to state claim 14 is concerning the claim 3 rejection. However, the Examiner has failed to provide a proper motivation to combine all the above mentioned references. Therefore, the rejection of claim 14 is improper and a finality would be premature.

VI. Entry of Amendment

Entry of the foregoing amendments to the claims is proper under 37 C.F.R. 1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove the basis of the outstanding rejections and to place all claims in condition for allowance. The foregoing amendments, and explanations, could not have been made earlier because they are merely responsive to issues newly raised in Paper No. 20050505.

VIII. Withdrawal of Finality

The Examiner stated that the new grounds for rejection are necessitated by the amendments

by the Applicant. However, this is not correct. As seen in claim 1 for example, the amendment was only done for clarification reasons of lending consistency in the use of facsimile as it seen in line 3. However, this would afford a whole new rejection and new references applied. The same is true for the amendments of claims 1, 2, 4-8, 11, 13, 15 and 17.

The *Manual of Patent Examining Procedure* (MPEP) states “Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art” (MPEP § 706.07(a)).

Therefore, the MPEP § 706.07(a) indicates that a second action on the merits ***will not be made final*** if it includes a rejection, on newly cited art, of any claim not amended by applicant in spite of the fact that other claims may have been amended to require newly cited art.

Furthermore, the definition of “a new ground for rejection” does not only refer to newly cited references, but to the below mentioned new grounds for rejection as MPEP 706.07(a) specifically mentions the case of newly cited references separately from “a new ground for rejection” afterwards as “Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly

cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.”

For all of the foregoing reasons, the Applicant respectfully believes that the Paper No. 20050505 is a premature final Office action because of the new grounds for rejection of claims 1-20 were not necessitated by amendment nor based on information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p).

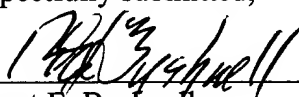
Respectfully, the Examiner is improperly using an amendment for clarification reasons that was intended to help the Examiner and to expedite the prosecution, as an excuse to generate a new ground for rejection without giving the Applicant a reasonable ability to respond by ending prosecution with an order of finality. The MPEP §706.07 states that the final rejection is in order a clear issue should be developed between the examiner and applicant. Here, it is clear no such clear issue has been developed with this new ground rejection which does not afford the Applicant a proper way to reply by giving a finality of the prosecution.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the

examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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